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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,578	02/27/2002	James L. DiGuseppi	9250-29	6023

7590

07/03/2006

bioMerieux, Inc.  
Patent Department  
100 Rodolphe Street  
Durham, NC 27712

EXAMINER
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SRIVASTAVA, KAILASH C

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/084,578	<b>Applicant(s)</b> DIGUISEPPI ET AL.	
	<b>Examiner</b> Dr. Kailash C. Srivastava	<b>Art Unit</b> 1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9, 11-18 and 20-28 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Applicants' amendment and remarks filed 28 March 2005 in response to Office Action mailed 11 January 2005 is acknowledged and entered.
2. Examiner very much appreciates that applicant labels each page of the response and amendment referred above with Application Serial Number and the date of the amendment/response. This practice immensely minimizes the papers lost during transaction/transmission. Examiner suggests that for the prosecution of application to be further expedited if applicants would also cite in the header of the each page of response/amendment, the Attorney Docket Number along with Application Serial Number and date of amendment/response.
3. Applicants are notified that the previous Office Action mailed 11 January 2005 and the Office Action mailed 04 April 2005 accompanying the Interview Summary of the interview conducted on 15 February 2005 are hereby vacated and the prosecution is re-opened in this application.
4. Applicants' arguments and remarks filed 28 March 2005 are fully and carefully considered, however, in view of the vacated previous Office Action cited *supra*, those remarks are moot.
5. Your application has been re-assigned to Art Unit 1655 at the United States Patent and Trademark Office (i.e., USPTO). The assigned Examiner to your application at the USPTO is Dr. Kailash. C. Srivastava. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Kailash C. Srivastava in Art Unit 1655.

## Claims Status

6. Claims 10 and 19 are cancelled.
7. Claims 1, 14 and 21-22 are amended.

8. Claims 1-9, 11-18 and 20-28 are pending.

***Election /Restriction***

9. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I, consisting of claims 1-9, 11-18 and 20-21 drawn to a device/system/apparatus, classified under Class 435, subclass 287.1, for example.
- Group II, consisting of claims 22-28, drawn to a method to collect and detect the growth of microorganisms in a specimen, classified under Class 435, subclass 34 or Class 436, subclass 63, for example.

***Inventions are Independent Or Distinct***

10. Inventions in Group II and Group I are related to each other as process/method and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the instant case, the method/process of invention encompassed in Group II (i.e., collecting and determining the microorganism) can be accomplished by a number of methods in microbiological art (See for e.g., U.S. Patent 5,545,834). Similarly, apparatus of invention in Group I for e.g., has numerous materially different uses than those instantly claimed. For e.g., to capture microbial spores from atmosphere or any sample (e.g., See U.S. Patent 6,838,292).

The inventions discussed above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. For example in search strategy for invention in group I one has to incorporate key words describing different specific features of the apparatus/system/device. Those specific

key words will not be required in the search strategy for the invention in Group II; rather a specific set of key words focused toward the properties of the microorganism will be the integral part for search strategy for invention in Group II. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (i.e., class and subclass), and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

11. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR §1.143).


12. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(I).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e.,

PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.

 Kailash C. Srivastava, Ph.D.

Patent Examiner

Art Unit 1655

(571) 272-0923

June 27, 2006



CHRISTOPHER R. TATE  
PRIMARY EXAMINER